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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/501,328	07/22/2004	Hansulrich Reisacher	255583USOPCT	9831

22850 7590 11/15/2005

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ALEXANDRIA, VA 22314

EXAMINER
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HAILEY, PATRICIA L

ART UNIT	PAPER NUMBER
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1755

DATE MAILED: 11/15/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/501,328

Applicant(s)

REISACHER ET AL.

Examiner

Patricia L. Hailey

Art Unit

1755

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 23 September 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-9 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-9 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)             | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)    | Paper No(s)/Mail Date. _____  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____   | 6) <input type="checkbox"/> Other: _____                                    |

Applicants' remarks and amendments, filed on September 23, 2005, have been carefully considered. No claims have been canceled; new claim 9 has been added.

Claims 1-9 are now pending in this application.

Support for new claim 9 can be found in the Specification at page 2, lines 35 and 38.

#### ***Withdrawn Rejections***

The 112(2) rejection of claim 1 stated in the previous Office Action, has been withdrawn in view of Applicants' amendment to claim 1.

The provisional obviousness-type double patenting rejection of claims 1-8 as being unpatentable over claim 1-10 of copending Application Serial No. 10/501,343, stated in the previous Office Action, has been withdrawn in view of Applicants' persuasive arguments traversing this rejection.

The copending application's claims require the presence of an additional component, that being an anionic surface-active additive. The claims in the instant application, in view of the claim language "consisting of", excludes the presence of additional critical components.

#### ***New Ground of Rejection***

As there was no indication of allowable subject matter in the previous Office Action, the following New Ground of Rejection is being made in view of the Examiner's

reconsideration of the pending claims, and in view of the newly discovered reference to Nyssen (U. S. Patent No. 6,646,023).

### *Claim Objections*

1. *Claims 1-9 are objected to because of the following informalities:*

In claim 1, the percentage ranges for components (A) and (B) *appear* to be based on the total amount of the pigment granules. However, the percentage range for Applicants' component (B) can be based on either (1) the total weight of the granules, or (2) on the total weight of the pigment. For purposes of examination, the claimed percentage ranges will be assumed as based on the total weight of the "pigment granules".

Clarification is respectfully requested.

### *Claim Rejections - 35 USC § 112*

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. *Claim 8 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.*

Claim 8 is indefinite for lacking antecedent basis for the limitation "pigmenting coatings, paints, inks, building materials, or cellulosic systems". Claim 7, from which claim 8 depends, does not recite this limitation.

Additionally, claim 8 is indefinite because there are no process limitations or steps recited therein. Claim 8 merely recites that "a liquid phase comprises water, organic solvents, or mixtures of water and organic solvents".

***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148

USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
  2. Ascertaining the differences between the prior art and the claims at issue.
  3. Resolving the level of ordinary skill in the pertinent art.
  4. Considering objective evidence present in the application indicating obviousness or nonobviousness.
6. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the

various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

**7. *Claims 1-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nyssen (U. S. Patent No. 6,646,023).***

*With respect to claims 1-4 and 9:*

Nyssen teaches solid pigment preparations comprising at least one organic or inorganic pigment, and at least one compound selected from the group consisting of polyether polyols, reaction products of alkylene oxides with alkylatable compounds such as fatty alcohols, said preparations having a mean weight average particle size of 20 to 2000  $\mu\text{m}$ . The solid pigment preparations are preferably obtained in the form of readily flowable, low-dust granules by spray-drying methods. See col. 2, lines 41-62 of Nyssen, as well as col. 7, lines 31-43, where an exemplary preparation comprising 30-99%<sup>^</sup> by weight of the organic or inorganic pigment and 1 to 100% by weight, based on the amount of the organic or inorganic pigment, of the aforementioned at least one compound, is disclosed (considered to read upon the percentage ranges of claim 1).

This disclosure is considered to read upon the limitations “at least one pigment” and “at least one nonionic surface-active additive based on polyethers”, i.e., Applicants’ components (A) and (B) in the instant claims.

The organic or inorganic pigments are not subject to any limitation; exemplary pigments are disclosed by Nyssen at col. 2, lines 1-65.

Suitable compounds from the group of polyether polyols include block copolymers of ethylene oxide and/or propylene oxide (considered to read upon the limitation “alkylene oxide block copolymers” in claim 2), as well as block copolymers obtained by subjecting ethylene oxide and/or propylene oxide onto bifunctional alcohols or amines (considered to read upon the limitations of claims 3 and 4). See col. 3, line 66 to col. 4, line 21.

*With respect to claims 5 and 6:*

Nyssen discloses that the solid pigment preparations can be prepared in such a manner that the inorganic or organic pigment component is subjected to wet comminution in aqueous or aqueous-organic medium together with at least some of the at least one compound, followed by subsequent drying. See col. 7, lines 44-52 of Nyssen (considered to read upon claim 5).

Suitable drying methods include single-material spray-drying using high-pressure nozzles or spiral chamber nozzles (considered to read upon the limitation “spray tower” in claim 6). See col. 7, line 62 to col. 8, line 35 of Nyssen.

*With respect to claims 7 and 8:*

The pigment preparations may be used as colorants for coloring seed and seed-dressing materials (which may additionally contain inorganic or organic binders, e.g., film-forming polymers, biocides, protective colloids, or antifoams; considered to read upon the limitations “macromolecular organic or inorganic materials”). This use can be effected in any desired manner, such as by mixing the preparation with water (considered to read upon the “liquid phase” of claim 8), and stirring the resulting slurry treatment materials with the seed (considered to read upon “stirring” in claim 7). See col. 1, lines 28-39 and col. 8, lines 57-63 of Nyssen.

Although Applicants’ claims 7 and 8 recite the limitations “for pigmenting macromolecular organic or inorganic materials” and “for pigmenting coatings, paints, inks,...”, these limitations are considered statements of intended use. A recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim.

Lastly, while Nyssen discloses that the pigment preparations exhibit a mean weight average particle size of 20 to 2000  $\mu\text{m}$ , the reference is silent with respect to the claimed surface area. It would have been obvious to one of ordinary skill in the art at the time the invention was made to reasonably expect the pigment preparations of Nyssen to exhibit a surface area comparable to that respectively claimed, absent the showing of convincing evidence to the contrary, as this reference teaches pigment



preparations (1) containing the same components as recited in Applicants' claims, in comparable percentage ranges, and (2) exhibiting a particle size comparable to that respectively claimed.

It is well settled that when a claimed composition appears to be substantially the same as a composition disclosed in the prior art, the burden is properly upon the applicant to prove by way of tangible evidence that the prior art composition does not necessarily possess characteristics attributed to the CLAIMED composition. In re Spada, 911 F.2d 705, 15 USPQ2d 1655 (Fed. Circ. 1990); In re Fitzgerald, 619 F.2d 67, 205 USPQ 594 (CCPA 1980); In re Swinehart, 439 F.2d 2109, 169 USPQ 226 (CCPA 1971).

#### *Priority*

8. Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

Applicants' Priority Document or Documents was or were filed on July 22, 2004.

#### *Conclusion*

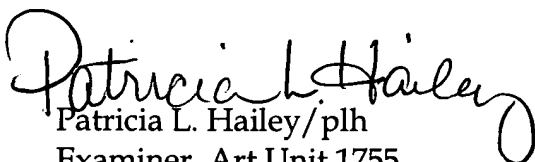
9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Patricia L. Hailey whose telephone number is (571) 272-1369. The examiner can normally be reached on Mondays-Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jerry Lorengo, can be reached on (571) 272-1233. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group 1700 Receptionist, whose telephone number is (571) 272-1700.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
Patricia L. Hailey/plh  
Examiner, Art Unit 1755  
November 9, 2005

  
J. A. LORENGO  
SUPERVISORY PATENT EXAMINER